

### **REMARKS**

Applicant respectfully requests reconsideration of this application in view of the foregoing amendment and following remarks.

#### **Status of the Claims**

Claims 1-36 are pending in this application. All of the pending claims are rejected. By this Amendment, claims 7-36 are cancelled and claim 1 is amended. No new matter has been added by this Amendment.

#### **Objection**

The drawings have been objected to under 37 C.F.R. §1.83(a). The Examiner indicates that the terms such as “plurality of light sources images” and “a second optical system for superimposing the beams from said plurality of light source images on said light modulating element, and said light amount adjusting means is disposed at a position whereat said plurality of light source images are projected” are not shown in the drawings.

In response, claims 7 and 15-17 for which the terms appear have been cancelled.

Applicant respectfully requests that this objection be withdrawn.

#### **Rejection under 35 U.S.C. §102**

Claims 1, 5-9, 14, 15, 17-32 and 36 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,592,227 to Ouchi et al. (“Ouchi”).

Claims 7-9, 14, 15, 17-32 and 36 have been cancelled rendering the rejections directed to these claims moot.

Claim 1 has been amended for further clarification. In particular, claim 1 has been amended to recite “an illuminating optical system ... having light amount adjusting means for

adjusting ...” In other words, the light amount adjusting means of the present invention is disposed within the illumination optical system. In contrast, the light quantity controlling means in Ouchi is disposed to or near the diaphragm in the projection optical system.

Accordingly, claim 1 is neither anticipated by nor rendered obvious in view of Ouchi for at least the reasons discussed above.

Reconsideration and withdrawal of the rejections of claim 1 under 35 U.S.C. §102(e) is respectfully requested.

**Rejection under 35 U.S.C. §103**

Claims 2-4, 10-13, 16 and 33-35 have been rejected under 35 U.S.C. §103(a) as being obvious over Ouchi in view of U.S. Patent No. 6,637,887 to Yamanaka (“Yamanaka”).

Claims 10-13, 16 and 33-35 have been cancelled rendering the rejections directed to these claims moot.

Claims 2-4 depend from amended claim 1 as shown above, and as discussed above, claim 1 is neither anticipated by nor rendered obvious in view of Ouchi.

Yamanaka is cited as disclosing an adjusting means having a variable stop. However, Yamanaka fails to show or suggest the inventive aspect of amended claim 1 as discussed above, i.e., an illumination optical system having a light amount adjusting means.

Accordingly, each of claims 2-4 is neither anticipated by nor rendered obvious in view of Ouchi and Yamanaka, taken either alone or in combination, for at least the reasons discussed above.

Additionally, Applicant respectfully submits that the Examiner has not made a valid rejection here because, as will be explained in detail, under 35 USC §103 the Examiner's primary reference, Ouchi, is not available against this application.

Ouchi has an effective filing date of September 21, 2001 (before the filing date of the instant case, i.e., January 10, 2002) and was issued as U.S. Patent No. 6,592,227 on July 15, 2003 (after the filing date of the instant case).

Further, the present case is assigned of record to Canon Kabushiki Kaisha. Ouchi is also assigned to the same assignee as the instant case.

Thus, while Ouchi, on its face may qualify as prior art under §102(e), §103(c) precludes its use in this case. Section 103(c) expressly so provides in stating as follows:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Therefore, Ouchi cannot be used to reject the claims of this application.

Applicant accordingly respectfully requests that this rejection in view of Ouchi be withdrawn, rendering the so rejected claims allowable over the art of record.

Applicant has not individually addressed the rejections of all of the dependent claims because Applicant submits that the independent claims from which they respectively depend are in condition for allowance as set forth above. Applicant however reserves the right to address such rejections of the dependent claims should such be necessary.

Applicant believes that this application is in condition for allowance and such action is respectfully requested.

**AUTHORIZATION**

No petitions or additional fees are believed due for this amendment and/or any accompanying submissions. However, to the extent that any additional fees and/or petition is required, including a petition for extension of time, Applicant hereby petitions the Commissioner to grant such petition, and hereby authorizes the Commissioner to charge any additional fees, including any fees which may be required for such petition, or credit any overpayment to Deposit Account No. 13-4500 (Order No. 1232-4808). A DUPLICATE COPY OF THIS SHEET IS ENCLOSED.

An early and favorable examination on the merits is respectfully requested.

Respectfully submitted,  
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